Hearing: January 6, 1999

Paper No. 14
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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUG. 18, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re New York Fragrance, Inc.

Serial No. 75/194,506

Sam P. Israel for applicant.

Geoffrey M. McNutt, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Quinn, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by New York Fragrance, Inc. to register the mark AMERICAN EAGLE for "perfumes, colognes, shampoos, body powder, toilet water, hair conditioner, after shave lotion, [and] shaving cream."[1]

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the

basis that applicant's mark, if applied to applicant's goods, would so resemble the previously registered AMERICAN EAGLE OUTLET and AMERICAN EAGLE OUTFITTERS marks, owned by a single entity, for a variety of goods and services, as to be likely to cause confusion. The cited marks are as follows: AMERICAN EAGLE OUTLET for discount store services in the field of clothing, footwear and accessories;[2] and AMERICAN EAGLE OUTFITTERS for clothing, namely coats, vests, parkas, anoraks, pants, jeans, shorts, sweaters, shirts, underwear, neckwear, headwear, belts, hoisery, skirts, jackets, blazers, and fleecewear; footwear, slippers, leather and rubber boots and insoles; leather care products; necklaces, earrings, and wristwatches; and stationery, calendars, compasses and flashlights.[3]

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[1] Application Serial No. 75/194,506, filed November 7, 1996, alleging a bona fide intention to use the mark in commerce.

[2] Registration No. 2,031,388. The word "Outlet" is disclaimed.

[3] Registration Nos. 2,086,693, 2,050,115, 1,921,343, 1,916,360 and 1,597,199. The word "Outfitters" is disclaimed, and in two of the registrations, the word "American" also is disclaimed.

When the refusal was made twice,[4] applicant appealed.[5] Applicant and the Examining Attorney submitted briefs,[6] and both appeared at an oral hearing before the Board.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are

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[4] Applicant has argued for reversal based, in part, on the fact that the Examining Attorney, after essentially withdrawing the Section 2(d) refusal, reinstated same. A review of the file shows that the reinstatement of the refusal was made a mere eleven days after the Examining Attorney's self-confessed "inadvertent error." Although this portion of the examination undoubtedly is regretted, it hardly warrants reversal of the refusal.

[5] After refusing registration on the bases of registrant's previously issued registrations, the Examining Attorney suspended further action pending the disposition of one of registrant's pending applications. When the underlying application matured into Registration No. 2,086,693, the Examining Attorney, in a non-final Office action dated November 21, 1997, refused registration based on the recently issued registration for the first time. Applicant then filed its appeal. While this appeal technically was premature inasmuch as the refusal based on Registration No. 2,086,693 was raised only one time, the Board went ahead and instituted the appeal. Inasmuch as this specific Section 2(d) refusal is substantially similar to the earlier refusals, and since applicant's brief fully addresses all of the refusals, it is in the interests of judicial economy to decide the appeal at this time.

[6] Both applicant and the Examining Attorney submitted additional evidence with their appeal briefs. More specifically, applicant submitted a second declaration of its president, and a computer printout which includes third-party registrations of AMERICAN EAGLE marks. The Examining Attorney submitted excerpts retrieved from the NEXIS database which, according to the Examining Attorney, bear on the renown of registrant in the retail trade. Suffice it to say that the evidence, which was not timely introduced during the prosecution of the application, does not form part of the record on appeal. Trademark Rule 2.142(d). Accordingly, we have not considered any of the newly submitted evidence in reaching our decision. We hasten to add that, even if any or all of the evidence were considered, we would reach the same result on the likelihood of confusion issue.

relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. Federated Food, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning our consideration to applicant's mark AMERICAN EAGLE and registrant's mark AMERICAN EAGLE OUTFITTERS and AMERICAN EAGLE OUTLET, we agree with the Examining Attorney that they are substantially similar in sound, appearance and meaning. Applicant's attempts to distinguish its mark from the marks of registrant, which include OUTLET or OUTFITTERS, simply fall far short. Applicant contends that the presence of these terms gives registrant's marks "a distinctive outdoors and non-prestige ("outlet") quality, thereby differing measurably from that intended by [applicant] in terms of the overall impression imparted to consumers." Applicant's president, Rama Krishna Cherukuri, has weighed in with his declaration wherein he essentially states that the marks are not likely to cause confusion in the marketplace.

Registrant's mark clearly is dominated by the words AMERICAN EAGLE which are identical to the entirety of the mark sought to be registered by applicant. Although we have considered the marks in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." Id. at 751.

In the case at hand, the disclaimed words "OUTFITTERS" and "OUTLET" clearly are subordinate to the words "AMERICAN EAGLE." Moreover, the words "AMERICAN EAGLE" alone would likely be used in calling for registrant's goods and services. In any event, it is the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific

impression of trademarks or service marks. See: In re United States Distributors, Inc., 229 USPQ 237, 239 (TTAB 1986). Further, the record is devoid of evidence of any third-party uses or registrations of the same or similar marks for similar types of goods and services to those involved here.

With respect to the similarity between applicant's goods and registrant's goods and services, at the outset, it should be noted that it is not necessary that the goods and/or services be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods and/or services originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). Moreover, the Board has stated that the degree of similarity in the goods/services need not be as great where the marks are essentially identical. Warnaco Inc. v. Adventure Knits, Inc., 210 USPQ 307, 315 (TTAB 1981).

In the present case, we find that applicant's goods are sufficiently related to registrant's goods and services that, when marketed under substantially similar marks, consumers are likely to be confused. The Board is hardly breaking new ground in finding that clothing and cosmetics/personal care products are related for purposes of a likelihood of confusion analysis. See, e.g., The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc., 220 USPQ 1069 (TTAB 1983); In re Barbizon International, Inc., 217 USPQ 735 (TTAB 1983); In re Arthur Holland, Inc., 192 USPQ 494 (TTAB 1976); and S. Rudofker's Sons, Inc. v. "42" Products, Ltd., Inc., 161 USPQ 499 (TTAB 1969). The goods would be sold in the same types of stores to the same classes of purchasers.

In finding that applicant's goods are related to registrant's goods and services involving the sale of those goods, we have considered the several third-party registrations based on actual use in this country which the Examining Attorney has submitted. The registrations show marks such as BANANA REPUBLIC, GAP, EDDIE BAUER, ABERCROMBIE FITCH, BENETTON and VICTORIA'S SECRET which, in each instance, are registered for both the types of goods and services marketed by applicant and by registrant. Although these registrations are not evidence that the

different marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods and services listed therein are of a kind which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

In connection with this point, we particularly note that registrant itself has shown a desire to follow the lead of others in the field in extending its brand to cover the types of goods listed in the involved application. As highlighted by the Examining Attorney, registrant owns two pending applications (currently suspended to await the disposition of this appeal) to register the mark AMERICAN EAGLE OUTFITTERS for hair and body shampoo, soap, moisturizing body lotion, bath salts, shower gel, and perfume.[7]

Finally, to the extent that any of the points raised by applicant may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re

[7] Application Serial Nos. 75/211,730 and 75/367,707.

Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

We conclude that consumers familiar with registrant's clothing, footwear, and jewelry sold under the mark AMERICAN EAGLE OUTFITTERS, and discount store services rendered under the mark AMERICAN EAGLE OUTLET would be likely to believe, upon encountering applicant's mark AMERICAN EAGLE for perfumes, colognes, shampoos, hair conditioners and the like, that the goods and/or services originated with or were somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.

T. J. Quinn

H. R. Wendel

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial
and Appeal Board